

## **Remarks**

### **I. Introduction**

This is in response to the Final Office Action dated November 12, 2008. In response to the finality of the Office Action, Applicants submit a Request for Continued Examination herewith.

The Office Action rejected claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,912,564 to Appelman et al. ("Appelman") in view of U.S. Patent Application Publication 2002/0087646 to Hickey et al. ("Hickey").

In response, Applicants present the remarks below. Claims 1-22 remain for consideration.

### **II. Rejections under 35 U.S.C. §103**

Independent claims 1, 3, and 18 were rejected as being unpatentable over Appelman in view of Hickey.

In order to "establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. Neither of the cited references, either alone or in combination, teach all of the claim limitations of independent claims 1, 3 and 18. Therefore, Applicants request the withdrawal of the rejections under 35 U.S.C. §103(a).

The subject area of the present invention relates generally to digital communication and, more particularly, to email and instant messaging (IM). An email user interface 500 is shown in Figure 4A displaying a specific user's email folders, which, in this example, are Curly's email folders. Figure 4A also shows user interface 500 including group email folder collection 501a. Page 18, lines 16-25 of the specification indicate that email messages directed to Curly, as an individual, are

displayed in the user email folder collection 401a labeled "Curly," while email messages directed to the email address of a group, of which Curly is a member, are displayed in group email folder collection 501a. Page 21, line 24 through page 22, line 16 of the specification indicate that

email messages in the group email folder have an indicator that indicates whether or not the email message has been accessed...by a particular user. Unlike messages in the individual user email mailbox, which are usually accessible by only one associated user, the messages in the group email mailbox are accessible by every member of the predefined group. Hence, if both Curly and Moe are members of the predefined group, then both Curly and Moe may access the email messages from the group email mailbox. For this reason, each email message in the group email folder collection 501b preferably has a separate indicator for each of the predefined members of the group. The separate indicators for each of the users are also referred to herein as access indicators. Thus, for example, if both Curly and Moe are members of the predefined group, then the email message may have a first indicator for Curly and a second indicator for Moe. Hence, when Curly accesses an email message in Curly's group email folder collection 501a, then the first indicator may be reset to indicate that Curly has accessed the email message. Thus, even though the first indicator may be altered when Curly accesses the group email message, the second indicator may be unchanged if Moe has not accessed the email message. In this regard, user-based access indicators facilitate organization of group email messages on an individual-by-individual, or user-by-user basis.

This aspect is contained in the limitation "wherein the group email message includes an access indicator for each member of the group, the access indicator configured to indicate which members of the group have accessed the group email message" recited in independent claim 1. The cited references, either alone or in combination, do not disclose this limitation.

The Office Action admits that Appelman does not explicitly teach the limitation "wherein the group email message includes an access indicator for each member of the group, the access indicator configured to indicate which members of the group have accessed the group email message" recited in independent claim 1. The Office Action alleges that this limitation is disclosed by Hickey paragraphs [0011], [0016], and [0043].

Hickey is directed to a system and method for a group electronic mailbox that enables multiple users to work collaboratively and simultaneously with one or more

electronic communications received in the group e-mail mailbox. (Hickey Abstract) Paragraph [0011] of Hickey states that “[i]t is a further aspect of the invention to provide tools that allow members or users of a group to selectively operate on [received] electronic communications.” Paragraph [0016] of Hickey further elaborates stating that “[w]hen an authorized member of the group takes an action with regard to the electronic communication, other members of the group can see what has been done. Thus, the members of the group can coordinate their activities with respect to the electronic communication.” Paragraph [0043] of Hickey describes how other members of the group can see what has been done stating that “[i]n response to acts by one member of group 22A1 that cause a status change, a signal is transmitted to update that associated status indicator 57A1 for any other group member viewing status indicator 57A11.”

Although status indicator 57A1 of Figure 6 shows whether a message has been read or answered by **any member** of the group, the status indicator does not include an indicator for each member of the group indicating whether **each member** of the group has read or answered the message. Thus, the status indicator of Hickey changes to ‘read’ or ‘answered’ **after any group member has read or answered the message**. There is no description in Hickey of separate status indicators for each group member to indicate **which** group members have read or answered a message. Thus, Hickey does not disclose a group email message including “an access indicator for each member of the group, the **access indicator configured to indicate which members of the group have accessed the group email message**” recited in independent claim 1.

Since Appelman and Hickey, alone or in combination, fail to disclose each and every limitation of independent claim 1, the cited references cannot render independent claim 1 unpatentable under 35 U.S.C. §103(a). Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 1 under 35 U.S.C. §103(a). Independent claims 3 and 18 each contain a limitation similar to the limitation discussed above in connection with independent claim 1. As such, independent claims 3 and 18 cannot be rendered unpatentable under 35 U.S.C. §103(a) for the same reasons

discussed above in connection with independent claim 1. Accordingly, Applicants respectfully request withdrawal of the rejections of independent claims 3 and 18 under 35 U.S.C. §103(a).

For the reasons discussed above, all independent claims are allowable over the cited art. Allowance of all independent claims is requested.

All remaining dependent claims are dependent upon an allowable independent claim and are therefore also allowable. In addition, as discussed immediately below, claims 6, 15, and 16 contain further limitations that render them separately patentable over the art cited in the Office Action against these claims.

Dependent claims 6 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Appelman in view of Hickey. Page 13 line 13 through page 14, line 4 of the present specification indicate that a user profile may include a user type that designates whether or not the user is an administrator, a guest, or a user having limited privileges and access to email user interface 500. This aspect is included in dependent claims 6 and 15, each of which recites the limitation “assigning a user type associated with the user.” The Office Action indicates that Figure 9 of Appelman discloses the limitations of claims 6 and 15. Although Appelman Figure 9 shows “Gostastepsu” under the “Friends” heading of Buddy List 900, Gostastepsu is a contact of a user further categorized as a “Friend” of the user. The designation of “Gostastepsu” as a friend does not provide any information or designation of Gostastepsu’s user type as defined in the present specification. Thus, Appelman does not disclose the limitation of “assigning a user type associated with the user” recited in dependent claims 6 and 15. The Office Action does not indicate that Hickey discloses this limitation. Further, Applicants have reviewed Hickey and Hickey does not disclose the limitation of “assigning a user type associated with the user” recited in dependent claims 6 and 15. Thus, the cited references, alone or in combination, fail to disclose each and every limitation of dependent claims 6 and 15. As such, the cited references cannot render claims 6 and 15 unpatentable under 35 U.S.C. §103(a).

Dependent claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Appelman in view of Hickey. Dependent claim 16 adds the limitation “assigning a collection of IM accounts to the user.” As shown in Figures 14, 15, and 16, a single user having multiple IM accounts can enter IM account information in a different interface for each account. As described on page 32, line 23 through page 33, line 2, the information is stored in a centralized database. Thus, a collection of IM accounts are assigned to a single user. The Office Action states that Appelman column 11, lines 45-47 disclose this limitation. Appelman column 11, lines 45-47, in total, state “[t]he tandem database 6380 includes a system of folders that store electronic data for subscribers of the host system 610.” The cited section of Appelman does not disclose assigning IM accounts to a user. Further, although Appelman does disclose an IM account associated with a user, nowhere does Appelman disclose more than one IM account being assigned to a single user. Thus Appelman does not disclose “assigning a collection of IM accounts to the user” as recited in dependent claim 16. The Office Action does not indicate that Hickey discloses the limitation of claim 16. Applicants have reviewed Hickey and Hickey does include any information concerning instant messaging. Thus Hickey fails to disclose the limitation missing from Appelman. The cited references, alone or in combination, do not disclose each and every limitation of dependent claim 16. As such, the cited references cannot render claim 16 unpatentable under 35 U.S.C. §103(a).

III. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joe G. Fenske", written over a horizontal line.

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